REMARKS/ARGUMENTS

Non-elected claims 17-19 are canceled without prejudice or disclaimer. Further, new claim 20 is added. Therefore, claims 1-16 and 20 are the claims currently pending in the present application.

New claim 20 is added so as more fully to claim patentable aspects of applicant's invention. Claim 20 introduces no impermissible new matter. Claim 20 is patentable for at least the same reasons as independent claim 1, from which it depends.

Claims 1-5, 8, 11 and 14 are amended to clarify features recited thereby.

Applicant thanks the Examiner for acknowledging the claim for foreign priority and the receipt of the priority documents.

Further, applicant thanks the Examiner for acknowledging review and consideration of the references cited in the Information Disclosure Statement filed on February 26, 2004.

Rejection of Claims 4, 8 and 14 Under 35 U.S.C. § 112

Claims 4, 8 and 14 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4, 8 and 14 are amended. Accordingly, this rejection should now be withdrawn.

Rejection of Claims 1, 3-8, 10-14 and 16 Under 35 U.S.C. § 102

Claims 1, 3-8, 10-14 and 16 are rejected under 35 U.S.C. § 102 as being anticipated by Lee et al., U.S. Patent Application Publication No. US2003/0090352. Reconsideration of this rejection is respectfully requested.

Among the problems recognized and solved by applicant's claimed invention is that a medical device, for example an endoscope unit, needs to be sterilized under high temperature and high pressure conditions, for example by use of an autoclave apparatus. According to an aspect of applicant's claimed invention, a switching unit is accommodated inside an air-tight unit with a biasing unit that biases the moving member from another position to the position in which no

operation is designated.

Claim 1 requires biasing the moving member from another position to the position in which no operation is designated.

Lee discloses a hermetically sealed electrical switch assembly that provides ON/OFF switching. Lee does not disclose or suggest a biasing unit that biases the moving member from another position to the position in which no operation is designated. The Office Action alleges that the frictional resistance inherent in any switch is equivalent to the biasing means for the moving member (Office Action, page 3).

Lee does not disclose or suggest a biasing unit that biases the moving member from another position to the position in which no operation is designated. First, it is respectfully submitted that by equating the frictional resistance inherent in any switch with the biasing means, the Office Action in effect reads out from the claim the biasing unit recitation of the claim, because any switch movable between physical positions would encounter resistance in movement.

Second, Lee does not disclose or suggest biasing the moving member from another position to the position in which no operation is designated. That is, while a frictional resistance may inherently bias a moving member to remain stationary, a frictional resistance of an ordinary switch would not bias the moving member from another position to the position in which no operation is designated. Therefore, Lee does not disclose or suggest the recitations of independent claim 1.

Moreover, independent claims 1, 5 and 11 require a switching unit (or switching means per claim 11) controlling specified functional operations in an endoscope unit.

Lee does not disclose or suggest an endoscope unit. As discussed, Lee is directed to a sealed electrical switch assembly. Therefore, Lee does not disclose or suggest the recitations of independent claims 1, 5 and 11.

Rejection of Claims 1-16 Under 35 U.S.C. § 103

Claims 1-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Taira, U.S. Patent No. 4,982,726 in view of Horton, U.S. Patent No. 5,701,200 and further in view of Giannini, U.S. Patent No. 4,025,885. Reconsideration of this rejection is respectfully requested.

Independent claims 1, 5 and 11 require moving the moving member disposed inside the air-tight unit into the position in which an operation is designated in accordance with the operation of the operating member disposed on an outside of the air-tight unit. Further, independent claims 5 and 11 require varying the position of the moving member disposed inside the air-tight unit in accordance with the operation of the operating member disposed on the outside of the air-tight unit.

Taira discloses an endoscope system with a suction channel of a controllable strength of the suction (Taira, Abstract), in which a spring biases a switch means that is located outside of the housing of the scope grip portion 8.

The Office Action acknowledges that Taira fails to disclose that the body unit is air-tight and further fails to disclose an arrangement of no physical contact between the operation member operable by a user and the moving member (Office Action, page 4). The Office Action however first takes the position that such a feature would be obvious and "almost inherent" due to the intended use of a medical endoscope (Office Action, page 5).

Applicant respectfully submits that Taira itself, as acknowledged by the Office Action, does not disclose an air-tight system. Therefore, it would be difficult for the Examiner to maintain the position that such an air-tight endoscope unit, absent in the primary reference cited, would be an "almost inherent" feature. The Office Action cites Giannini which discloses a sealed permanent magnet switch and teaches that in certain environments, such as an explosive atmosphere where it is desirable to completely isolate switch contacts, isolation protects the environment from any sparks that may be generated during switching and also protects the switching mechanism from the environment (Giannini, column 1, lines 16-23).

Horton discloses an air-tight endoscope but does not address the above-discussed features recited in claim 1. Taira is silent with respect to an air-tight endoscope. Further, Taira does not disclose, suggest or motivate for replacing the switch that it discloses or combining it with a switch structure of the type disclosed in Giannini, even if the endoscope of Taira is made with an air-tight structure.

It is respectfully submitted that the Office Action cites no teaching provided in the cited art that would motivate for the proposed combination of Giannini and Taira. The Examiner

alleges that the motivation would have been that such a coupling would eliminate the direct electrical path from the inside to the outside of the housing, providing protection against electrical shock (Office Action, page 5), and further that the arrangement would constitute an improved switch structure in terms of sealing properties due to the low structural integrity (susceptibility to tearing or to deterioration from use or cleaning) of the sealing structure of Taira. However, the Office Action does not allege that such motivations are taught by the cited art. For example, a motivation such as improving the structural integrity of the switch of Taira is not disclosed by the cited references.

In addition, a motivation such as providing protection against electrical shock, while also not disclosed in the cited art, could reasonably motivate for many different types of solutions but does not render obvious applicant's claimed invention. Similarly, such other general motivations as improving structural integrity or preventing deterioration, even if they had been disclosed in the cited art, without more specific guidance, would not have motivated for the solutions provided by applicant's invention. It is respectfully submitted that the rejection is based on impermissible hindsight reconstruction based on applicant's own disclosure to arrive at the proposed combination from the cited teachings.

In a similar vein, it is respectfully submitted that Taira, Horton or Giannini do not disclose or suggest the problems recognized and solved by applicant's claimed invention, including the problem of providing a switch for an endoscope unit that is resistant to the high pressure environment of an autoclave sterilization process. Therefore, it is respectfully submitted that claims 1, 5 and 11 would not have been obvious to a person of ordinary skill in the art based on Taira, Horton and Giannini, even taken together in combination.

Claims 2-4 depend from independent claim 1, claims 6-10 depend from independent claim 5, and claims 12-16 depend from independent claim 11. Thus, claims 2-4, 6-10 and 12-16 are patentably distinguishable over the cited art for at least the same reasons as independent claims 1, 5 and 11, respectively.

In view of the foregoing discussion, reconsideration of the rejections is respectfully requested and allowance of the claims of the application is believed to be warranted. Should the Examiner have any questions regarding the present Amendment or regarding the application

generally, the Examiner is invited to telephone the undersigned attorney at the below-provided telephone number.

THIS CORRESPONDENCE IS BEING SUBMITTED ELECTRONICALLY THROUGH THE PATENT AND TRADEMARK OFFICE EFS FILING SYSTEM ON November 7, 2006.

Respectfully submitted,

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